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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/827,029	04/19/2004	Thomas Matheyka	CMD 303B	2746
22222	7590	08/23/2005	EXAMINER	
GEORGE R CORRIGAN 5 BRIARCLIFF COURT APPLETON, WI 54915			TRUONG, THANH K	
			ART UNIT	PAPER NUMBER
			3721	

DATE MAILED: 08/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/827,029	<b>Applicant(s)</b> MATHEYKA ET AL.	
	<b>Examiner</b> Thanh K. Truong	<b>Art Unit</b> 3721	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 14 June 2005.  
 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.  
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 20-30 is/are pending in the application.  
     4a) Of the above claim(s) 27-30 is/are withdrawn from consideration.  
 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
 6) ☒ Claim(s) 20-26 is/are rejected.  
 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.  
 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☒ All    b) ☐ Some \*    c) ☐ None of:  
         1. ☒ Certified copies of the priority documents have been received.  
         2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
     \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/10/4</u> | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election without traverse of Group I, claims 20-26, in the reply filed on June 14, 2005 is acknowledged.
2. Claims 27-30 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on June 14, 2005.

### **Continuing Data Should Be Updated**

3. Applicant is respectfully requested to carefully review all continuing data for accuracy and completeness, and the status of each parent application should be updated where appropriate. It is respectfully requested that a new paragraph with the heading CROSS-REFERENCE TO RELATED APPLICATIONS be inserted at page 1, between the Title of the Invention and the heading BACKGROUND.

### ***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 20-26 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 4 of U.S. Patent No. 6,519,922. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to omit the specific elements from the patent claims.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 20-26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 20, lines 12-16, introduce the term "passive device" and its function, however, this term is not described in the original specification. It is unclear what is the "passive device"? And what is the structure limitation of this "passive device" relative to the other structure limitations of the claimed invention. Furthermore, there is no disclosure in the specification to support the claimed limitation recited in lines 12-16 (of claim 20).

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 20-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "passive device" in claim 20, lines 12-16, is vague and indefinite because, it is unclear what the Applicant is referring to? And there is no disclosure to support this claimed limitation, and therefore, it is unclear what is the structure limitation of the term "passive device".

The term "tool carrier" in claim 20, lines 13, is vague and indefinite; because it is unclear what the Applicant is referring to? Is the "tool carrier" the same as the "tool mount" mentioned in lines 3 (of claim 20)?

Claim 20, lines 12-16 is vague and indefinite, because it is unclear what is the claimed limitation due to unspecified terms as mention above. Furthermore, the recitation: "the passive device affects the path ... the selected pair follows", lines 14-16, is unclear and confusing.

Similarly, claim 25 is vague and indefinite, because it is unclear and confusing.

Claim 20 recites the limitation "the near end" in line 16. There is insufficient antecedent basis for this limitation in the claim.

Accordingly, due to the indefiniteness of the recitation from lines 12-16 in claim 20, no patentable weight is given to the claimed limitation recites from lines 12-16.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 20-23, 25 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Hirsh et al. (**WO 98/42576**).

The Hirsh et al. reference discloses an apparatus comprising:

at least a pair of tool mounts (10, 54, 56) that follow an orbital movement, wherein the tool mounts have a near end and a distal end, and wherein the near end is linked to a device that imparts the orbital movement to the tool mounts (figures 1-5);

a first pair of opposing tools (12), each mounted on one of the pair of tool mounts, that cyclically engage the tube (36) and seal the foil tube in bag-length intervals during a portion of the orbital movement (figure 3);

a second pair of opposing tools (50), each mounted on one of the pair of tool mounts, that remove bulk goods from the area of the seal by a wiping motion effective in the run direction, linked to follow a path responsive to the orbital path (figure 3); and

The Hirsh et al reference is construed to anticipate the claimed limitation as recited from lines 12-16 of claim 20, as best understood by the examiner, as follow:

a pair of opposing passive devices (58), each mounted near the distal end of each tool mounts, effective during at least part of the portion of the orbital movement,

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wherein the passive device (58) affects the path of a pair of tools (50) such that the distal end of the pair of tools (50) follow a path parallel to a path the near end (50A) of the pair of tool (50) follows.

Regarding claims 21-23, figure 3 discloses passive device (58) is effective during at least all of the portion of the orbital movement, and at least the time the tube is engaged; the passive device is linked to the second pair of tools (50).

Regarding claims 25 and 26, figure 3 and page 8, lines 6-7 further disclose a second pair of opposing passive devices effecting the path of the second pair of tools.

### ***Allowable Subject Matter***

11. Claim 24 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

### ***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thanh K. Truong whose telephone number is 571-272-4472. The examiner can normally be reached on Mon-Thru 8:00AM - 6:30PM.

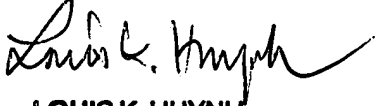
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on 571-272-4467. The fax phone number for the organization where this application or proceeding is assigned is 571-272-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

tk

August 17, 2005.

  
LOUIS K. HUYNH  
PRIMARY EXAMINER